

REMARKS

In the Office Action mailed May 25, 2006, the Examiner rejected claims 1-4, 6-15, 17-30 and 32-36. Applicants traverse those rejections.

I. Rejections under 35 USC 103

The Office Action rejected claims 1-4, 6-15, 17-30 and 32-36 under 35 USC 103 as being unpatentable over combinations of the following references: Locke et al. (US 6,291,019); Burton (US 5,925,466); Wade et al. (US 5,580,945); Cannady, Jr. et al. (US 4,480,001); Meader, Jr. et al. (US 4,025,683); Uhran et al. (US 4,145,512); Thomaides et al. (US 5,626,840). Applicants traverse these rejections below.

As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Court of Appeals for the Federal Circuit, in the case of In re Lee, 61 USPQ2d 1430 (CAFC 2002), wrote:

The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");... The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir.

2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In the case of In re Rouffet (CA FC) 47 USPQ2d 1453, 1457-1458 (July 1998), the court wrote:

Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. Section 103(a). This legal construct is akin to the "reasonable person" used as a reference in negligence determinations. The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. See In re Carlson, 983 F.2d 1032, 1038, 25 USPQ2d 1207, 1211 (Fed. Cir. 1993).

As this court has stated, "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of

obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Applicants continue to traverse the rejections of claims 1 and 2 and each of their dependents for all the reasons previously asserted. Those arguments are incorporated herein by reference and Applicants request reconsideration of those arguments.

While applicants believe that all of the currently pending claims should be allowed, Applicants assert that, at the very least, claims 3, 4 and 13 should be allowed. It will be understood that some of these argument apply to claims 1, 2 and their dependents as well.

Claims 3, 4 and 13

Each of claims 3, 4 and 13 recite at least the following elements:

- 1) a specific combination of primary and second amine;
- 2) aspartic acid ester;
- 3) application by spraying or robotic spraying; and
- 4) application to a bedliner of an automotive vehicle (e.g., a pickup truck).

Applicants contends that this combination of elements is patentable over the references of record along with the other elements in the claims.

A. Difference between Locke et al. and Claims of the Present Application

Locke et al. is directed to extremely fast curing compositions formed substantially entirely with primary amines that are designed to avoid any contamination of the vehicle paint or E-coat system. The compositions of Locke et al. are in contrast to the composition of the claims of the present application which allow for greater cure times due to their combination of primary and secondary amines.

Locke et al., at col. 1, lines 56-60 and at col. 2, lines 1-2, suggest that it is an object of Locke et al. to provide a "method which requires very little time in the

assembly process and advantageously will not contaminate the vehicle paint or E-coat system" and Locke et al. provide such a method through the use of a composition that "cures substantially instantaneously in an ambient environment". Moreover, it becomes clear from the examples of columns 13-18 of Locke et al. that its formulations are substantially directed to the use of primary amine to develop such a method and composition since these primary amines tend to react very quickly.

This objective of Locke et al. is in contrast to the claims of the present application which recite specific levels of primary and second amines (e.g., wherein the amount of the at least one secondary amine is between about 40% and about 80% by volume of the second component and the at least one primary amine is between about 10% and about 40% of the second component), which offer slower curing times and can allow for gelation and/or build-up of a layer of the composition prior to full curing. While Applicants acknowledge that Locke et al. suggests the possibility of both primary and secondary amines in a mixture, a true reading of Locke et al. actually suggests a much higher level of primary amine and does not suggest the levels of primary and secondary amine of the claims of the present application, particularly considering the end use of the amines in the claims of the present application.

This contrast between Locke et al. and the claims of the present invention becomes even more poignant when considered in conjunction with the recited application of the composition of the claims of the present invention. In particular, each of the claims of the present application suggest spraying of a coating upon a bedliner of an automotive vehicle (e.g., a pickup truck), which is not suggested by Locke et al. In such an application, the gelation of a coating composition and/or the build up of a layer of the composition prior to full curing can be particularly desirable in forming a layer of desired thickness that can protect such a bedliner. The skilled artisan would understand that the compositions suggested by Locke et al. would likely not allow for such gelation and/or build-up.

Locke et al. is in still further contrast to the claims of the present invention when the properties recited within the claims are considered. While the Office Action merely suggests that, "it would have been ... within the skill of one practicing in the art, through routine experimentation, to optimize the performance properties ...", it should

be clear that the nature, objective and use of the composition in Locke et al. is quite different from that of the claims of the present application. Thus, any optimization of the composition Locke et al. is unlikely to produce the properties of the claims of the present application.

B. Locke et al. lacks Aspartic Acid Ester

As admitted by the Office Action, Locke et al. does not suggest the use of an Aspartic Acid Ester. In contrast to this, the claims of the present application suggest that the amine component includes aspartic acid ester. However, the Office Action suggests that it would have been obvious to use such an aspartic acid ester since such is disclosed in Wade et al. Applicants contend that this assertion is misguided.

Neither Locke et al. nor Wade et al. suggest any particular reason for using polyaspartic acid ester in the compositions of the Locke et al. To the contrary, as previously discussed, the objective of Locke et al. is to provide a composition that almost instantaneously cures and Locke et al. accomplishes such through its use of primary amines. The amines of Wade et al., particularly those at column 4, lines 1-15, however, appear to be secondary amines. It is quite unlikely that the skilled artisan would believe that the amines of Wade et al. could be substituted into Locke et al. while maintaining the objective of Locke et al. This substitution of a secondary amine (i.e., from Wade et al.) into a reference (i.e., Locke et al.) that is directed toward the use of primary amines for achieving high cure rates is unlikely to be seen as desirable by the skilled artisan and is thus based upon hindsight.

C. Improper Combination of Burton

The Office Action, at page 3 thereof, suggests that Applicants arguments with respect to Burton are not convincing. The Office Action reads that, "Burton is only relied upon for teaching the substrate may be a vehicle bed liner" and that "The spraying process is inconsequential to the rejection ... Burton teaching that specialized equipment is not required is not a teaching that the process would not benefit from it, thus it does not teach away from the limitation to robotics."

Applicants contend that these statements lack merit. The statements suggest that the references being used to reject the claims of the present application are being viewed for their parts rather than their teachings as a whole. It is quite unlikely that the skilled artisan would be inclined to robotically spray a fast curing composition like that in Locke et al. upon a substrate (i.e., a bedliner) discussed in Burton where Burton is teaching the value of manual application of a slow curing composition to such substrate. These two application techniques and/or compositions are in contrast to each other and there is no clear motivation for the combination of the teachings of the two references. Additionally, Applicants contend that the contrast between these references further illustrates the differences between the application of the fast curing compositions of Locke et al. relative to slower curing compositions and their application to a bedliner as is claimed in the present application.

Applicants request reconsideration of the patentability of the claims of the present application and request that the claims of the present application, particularly claims 3, 4 and 13 be viewed as a whole since the nature of the composition and its use in these claims is quite different than in Locke et al.

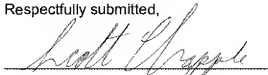
CONCLUSIONS

In view of Applicants' remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 04-1512 for any fee which may be due.

Respectfully submitted,

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